

REMARKS

Claims 2, 6-11, 13-15, 17 and 19 are pending in the instant application. Applicants have amended Claims 2, 9, 10, 11, 17 and 19. Claims 10, 17 and 19 have been withdrawn as being directed to non-elected subject matter. Claims 1, 3-5, 12, 16 and 18 have been cancelled without prejudice to filing a continuation application directed to that subject matter. The Examiner has rejected Claims 1-9 and 11-15 for the reasons noted below. Applicants respectfully traverse those rejections, in light of the amendments above and these remarks and request a reconsideration of the application.

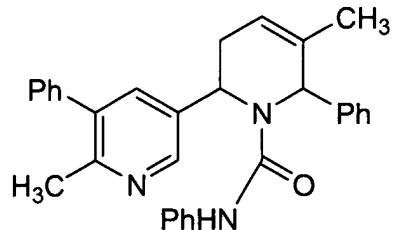
Applicants affirm the election made telephonically by Nicole Beeler of the invention of Group I and the species of Claim 8:

5-(2,5-difluorophenyl)-3-phenyl-3,6-dihdropyridine-1(2H)-carboxamide.

The Examiner has provisionally rejected Claims 1-5, 9, 11, 12, 13 and 14-15 on the ground of non-statutory obviousness-type double patenting over Claims 1-5, 10, 12-16 of pending U.S. Ser. No. 10/539,512. Applicants respectfully request that this rejection be held in abeyance until the claims of the '512 application are found allowable or the instant claims are found allowable.

The Examiner has provisionally rejected Claims 1-5, 9, 11, 12, 13 and 14-15 under 35 U.S.C. 101 on the ground of double patenting over Claims 1-5, 10, 12-16 of pending U.S. Ser. No. 10/539,512. Applicants respectfully request that this rejection be held in abeyance until the claims of the '512 application are found allowable or the instant claims are found allowable.

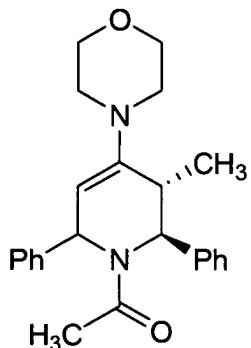
The Examiner has rejected Claims 1, 9 and 11 under 35 U.S.C. §102(b) as being anticipated by Hcplus 112:97889. The Examiner suggests that the following compound:



disclosed in Hcplus 112:97889 is a compound of the instant invention.

Applicants respectfully note that Claim 1 as originally filed is directed to tetrahydropyridine derivatives that are substituted at the 3- and the 5-positions with a non-hydrogen substituent (in Claim 1, R⁴ and R⁷ are not selected from H). Applicants further note that the illustrated Hcplus 112:97889 compound lacks a non-hydrogen substituent at the 5-position of the tetrahydropyridine ring. Applicants therefore respectfully contend that the compound of Hcplus 112:97889 cannot anticipate Claims 1, 9 and 11, because all of the elements of the instant claims are not found in the prior art compound.

The Examiner has rejected Claims 1, 10, 12, 13 and 14 under 35 U.S.C. §102(b) as being anticipated by Hcplus 1999:287417. The Examiner suggests that the following compound:



disclosed in Hcplus 1999:287417 is a compound of the instant invention.

Applicants respectfully note that Claim 1 as originally filed is directed to tetrahydropyridine derivatives that are substituted at the 3- and the 5-positions with a non-hydrogen substituent (in Claim 1, R⁴ and R⁷ are not selected from H). Applicants further note that the illustrated Hcplus 1999:287417 compound lacks a non-hydrogen substituent at the 3-position of the tetrahydropyridine ring. Applicants therefore respectfully contend that the compound of Hcplus 1999:287417 cannot anticipate Claims 1, 10, 12, 13 and 14, because all of the elements of the instant claims are not found in the prior art compound.

Applicants contend that because neither Hcplus 112:97889 nor Hcplus 1999:287417 anticipate the instantly claimed compounds, that the Examiner's rejections of the claims under 35 U.S.C. §102(b) are untenable and should be withdrawn. Despite this, Applicants note that Claim 1 has been cancelled without prejudice to filing a continuation application

directed thereto and Claim 2 has been rewritten in independent form. Therefore, the Examiner's rejections of Calim1 and 9-14 under 35 U.S.C. §102(b) is also moot.

The Examiner has rejected Claims 1-5, 10, 12-16 under 35 U.S.C. 112 first paragraph, as not reasonably providing enablement for using the compounds of the formula I as originally claimed. Applicants respectfully contend that the specification as filed fully discloses methods of making and testing compounds of the scope of original Claim 1 such that a person of ordinary skill in the pharmaceutical development and manufacturing art would readily be able to identify a instant compound having activity as an inhibitor of KSP (such an activity associated with use in the treatment of cancer). Applicants respectfully contend that the methods described in the application as filed for making and testing the instant compounds would provide sufficient basis for even a physician with an MD to be able to determine how changing a heterocyclic ring would affect biological activity.

The Examiner suggests that making and testing of a vast number of compounds would be required to determine if such compounds are "active" inhibitors of KSP. Appilcants respectfully contend that syntheses and testing of a limited number of representative compound to show that the variations questioned by the Examiner do have the expected activity. Furthermore, the Examiner has not provided concrete evidence that for compounds of the general structural class, such variations in structure do not lead to similar in vitro or in vivo activity.

However, in order to advance the prosecution of the instant application, Applicants have cancelled Claim 1 without prejudice and rewritten Claim 2 in independent form wherein the various substituents are defined as set out in Claim 1 as filed and on page 17 and 18 of the specification as filed. Applicants note that in light of the Claim 2 amendment, Claims 3-5 have also been cancelled without prejudice to filing a continuation application directed thereto.

Applicants respectfully contend that in light of the amended scope of Claim 2 there is sufficient disclosure in the specification as filed of compounds falling within that Formula II that the scope of Claim 2 is fully enabled and that the use of such compounds by one of ordinary skill in the art would not require undue experimentation. Applicants respectfully contend that the Examiner's rejection under 35 U.S.C. 112 first paragraph, is now moot and should be withdrawn.

Applicants contend that in light of the above remarks and amendments, Claims 2, 6-11, 13-15, 17 and 19 are allowable and an early Notice of Allowance is earnestly requested. If a telephonic communication with the Applicants' representative will advance the prosecution of

the instant application, please telephone the representative indicated below. Applicants believe no additional fees are due but the Commissioner is authorized to charge any fees required in connection with this amendment to Merck Deposit Account No. 13-2755.

Respectfully submitted,

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